

REMARKS

SUMMARY

In the Office Action of September 11, 2007, the Examiner rejected claims 13-16 and 34-36 based on 35 U.S.C. §112, and rejected all the claims based on 35 U.S.C. §103(a).

The Applicant has cancelled claims 1 through 36 and added new claims 49 through 58 directed to the handheld cleaning device. The Examiner did not reject any of the original claims for lack of novelty, and only rejected original claims 13-16 and 34-36 because these claims lacked clarity under 35 U.S.C. §112. This rejection is now moot in view of canceling these claims. The original claims 37 through 48 need no amendment to distinguish Applicant's method from the prior art because they define a non-obvious method invention and the rejection based on based on 35 U.S.C. §103(a) should be withdrawn for the reasons set forth below. New claims 49 through 58 define the Applicant's hand held cleaning device in terms that clearly distinguish it from the prior art and define a non-obvious invention.

Both new claims 49 through 58 and original claims 37 through 48 center round a hand held cleaning device "...bearing a visual advertisement..." Applicant's advertising method uses his hand held cleaning device at an "...entertainment event at least in part employing a substantially planar surface where at least a portion of the event is conducted..." Applicant's device "...bearing a visual advertisement..." is used to wipe liquid from the planar surface while (a) being televised or (b) observed by a spectator of the event or (c) both. Contrary to the Examiner's conclusion, all the claims define non-obvious subject matter for the following reasons:

REJECTION UNDER 35 U.S.C. §103(a)

Rational Analysis

KSR International Co. v. Teleflex Inc. 550 U.S. ___, 82 USPQ2d 1385, 1395-97, (2007) and MPEP §2143 require the Examiner to articulate clearly in a written, rational analysis explaining why

combining prior art supports a rejection under 35 U.S.C. §103(a). To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. The Examiner in rejecting claims 38 through 48 has failed to do this. Moreover, the attached Declaration of the Inventor presents evidence of non-obviousness that overcomes any conclusion that the cited prior art suggests the claimed invention.

Hindsight Approach

The Applicant objects to the hindsight approach adopted by the Examiner in rejecting the claims. It is well settled law that such an approach is strictly prohibited. After considering Applicant's disclosure, the Examiner has selected Garcia and Brach, Jr. et al as relevant prior art references showing some individual features which are similar to certain elements of Applicant's invention. There is nothing in these references, however, suggesting Applicant's invention, or combining references as the Examiner has done.

The correct way to resolve the question of obviousness is to follow the approach set forth in Graham v. John Deere, 383 US 1, 17, 148 USPQ 459, 467 (1966). In this case, the U. S. Supreme Court directed that three factual inquiries be made. These factual inquiries are:

1. Determining the scope and content of the prior art.
2. Ascertaining the difference between the prior art and the claims at issue.
3. Resolving the level of skill in the pertinent art.
4. Considering objective evidence indicating non-obviousness.

The Court of Appeals for the Federal Circuit in In re Fritch, 23 USPQ 2d 1780, deals specifically with obvious determinations. In Fritch, the Court on page 1783 states:

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."

As provided in M.P.E.P. Section 2143, before a *prima facie* case of obviousness under 35 USC 103 can be established, the following criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art references must teach or suggest all the claim limitations.

Applicant believes that the substantial evidence requirement established by In re Kotzab, 217 F.3d 1365 (Fed. Cir. 2000), is lacking. In re Kotzab states:

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. See 35 U.S.C. § 103(a) (Supp. III 1997); In re Dembiczak, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999). The ultimate determination of whether an invention would have been obvious under 35 U.S.C. § 103(a) is a legal conclusion based on underlying findings of fact. See Dembiczak, 175 F.3d at 998, 50 USPQ2d at 1616. We review the Board's ultimate determination of obviousness de novo. See id. However, we review the Board's underlying factual findings for substantial evidence. See In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000).

In re Kotzab further states:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the

invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

Failure to Meet the Substantial Evidence Requirement and No Rational For Combining References

The evidence is that until Applicant's invention no one used at entertainment events a mop with advertising thereon to mop up sweat or other liquid from the platform on which the event was being conducted. As the Declaration of the Inventor supports, no one saw mopping up sweat or other liquid from the platform on which the event was being conducted as a business opportunity.

The only evidence concerning original claims 37-48 bearing on this issue is the Examiner statements, page 5 of the Office Action of September 11, 2007, that

“...it is well known that sporting events are televised. Therefore, the use of Garcia's mop during a sporting event to remove liquid from a surface may be televised.”

and

“It is ... well known that spectators watch the event from nearby seats. Therefore, the use of Garcia’s mop during a sporting event to remove liquid from a surface may be observed by at least one spectator.”

GRAHAM ANALYSIS

Scope and Content of Prior Art:

Even if the Examiner’s statements are true, there is no suggestion or motivation in Garcia to place an advertisement on his mop so this advertisement would be televised or observed during the course of the event. Brach, Jr. et al shows a windshield cleaning device with a removable advertisement thereon. The Examiner makes a hindsight combination of Garcia and Brach, Jr. et al to reject Applicant’s original method claims 37 through 48. The Brach, Jr. et al cleaning device is a squeegee for wiping liquid from a windshield of an automotive vehicle. It does not include an absorbent pad for the liquid and is unsuited for use in mopping up a stage or platform where an entertainment event is conducted. The Brach, Jr. et al squeegee has nothing to do with entertainment events and has nothing to do with television.

Differences between Prior Art and Claims:

The principal difference between the references relied upon and Applicant's method invention as set forth in the original claims 37 through 48 is the references are devoid of any hint that a business opportunity is present by an advertisement on a mop used to wipe up liquid from the platform on which the entertainment event is being conducted.

The new claims 49 through 58 directed to Applicant’s handheld cleaning device call for a combination that is not suggested by the cited references Garcia, Brach, Jr. et al, Savage, Belsky et al, Saltzstein, Nelson, Hart, and Ramrattan used to reject original claims 1 through 36.

Specifically, claim 49 calls for “...a cleaning head having an underside and a topside bearing a visual advertisement...” The advertisement is “...on a removable cover member that overlies

and covers substantially the entire topside of the cleaning head...” An absorbent wiping member is “... detachably connected to the underside of the cleaning head that covers substantially the entire underside of the cleaning head...” An elongated handle has a first end “...connected at or near a central point of the topside cleaning head and a second free end enabling a user to grasp the free end and manipulate the cleaning head.”

Applicant contends that claim 49 defines a non-obvious combination of elements that is not suggested by any of the teaching in Garcia, Brach, Jr. et al, Savage, Belsky et al, Saltzstein, Nelson, Hart, and Ramrattan. The Applicant cannot anticipate how the Examiner could develop a rational analysis explaining why combining these prior art references supports a rejection of claims 49 et seq under 35 U.S.C. §103(a).

Level of Skill in the Pertinent Art:

One way to ascertain the level of skill in the pertinent art is to examine the references cited. None of these references in any way suggest Applicant's invention as defined by the original or new claims, which is indicative of the skill in the art to which Applicant's invention is related. Specifically, none of the references deals with television or advertising at entertainment events

Objective Evidence Indicating Non-obviousness:

The attached Declaration of the Inventor is objective evidence of commercial success and overcomes the subjective basis that the Examiner uses in rejecting the original claims. No one had any idea of the advertising method of claims 37 through 48 and these claims clearly define non-obviousness subject matter.

NO SURRENDER OF PATENTABLE SUBJECT MATTER & FESTO DOCTRINE

The Applicant in adding the new claims intends to claim broadly the subject matter of his invention and not surrender equivalent subject matter by unduly narrowing the scope of the claims. The claimed subject matter that the Applicant believes allowable is based on the

statements made by the Examiner in the last Office Action, taking into consideration the limitations of the English language and the inability of the Applicants to foresee all the possible equivalents that may be developed in the future. Consequently, the Applicant does not consider the submission of the new claims to be an amendment as contemplated in Festo Corp. v Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al 535 U. S. 722 (2002, resulting in surrendering any patentable subject matter. Therefore, the original and new claims are entitled to the application of the doctrine of equivalents under Warner-Jenkinson v. Hilton Davis Chemical Co., 520 U. S. 17 (1997).

Continuation

Applicants believe that the rejected claims are directed to novel and non-obvious subject matter. Nevertheless, Applicants reserve the right to file a continuation application to submit additional arguments or evidence why the rejected claims should be allowed, or submit other claims directed to the same subject matter as cancelled Claims 1 through 36, or to submit other claims directed to different subject matter disclosed but not claimed.

* * * * *

In view of the above, the application is deemed to be in a condition for allowance and such action is solicited.

TELEPHONE INTERVIEW

If the Examiner believes that a telephone interview would advance the allowance of this application, Applicant's attorney requests the Examiner call to arrange a date and time for such interview after having an opportunity to review the above.

EXTENSION OF TIME

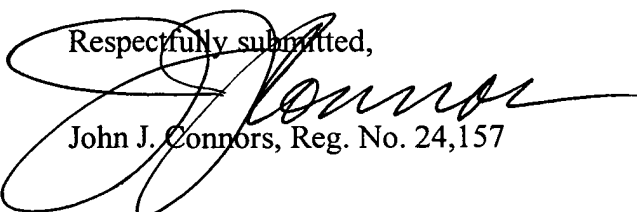
A one-month extension to reply to the last Office Action is requested as indicated below.



CUSTOMER NUMBER

Please note Applicant's attorney **Customer No. 021905**, and confirm that this number is entered in your records in connection with the above-identified application.

Respectfully submitted,


John J. Connors, Reg. No. 24,157

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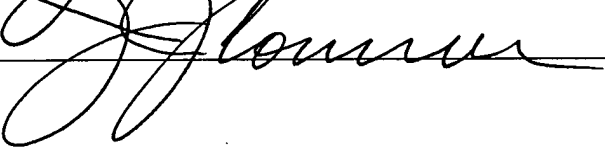
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being mailed with the United States Postal Service as First Class Mail, the correct postage paid, in an envelope addressed to: U. S. Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on , 2008

By: 

REQUEST FOR EXTENSION OF TIME

It is respectfully requested that the time for filing the above response in the above-identified patent application be extended from December 11, 2007 to January 11, 2008. Check No. 4242 in the amount of \$ 69 for the fee for this extension is enclosed herewith.

By: 

AUTHORIZATION TO CHARGE/CREDIT DEPOSIT ACCOUNT

The commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 03-2830.

By: 